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REMARKS / ARGUMENTS

Amendments to the Claims

The claims have been amended to eliminate the possibility that they will be construed as means-plus-function claims. New claims 21-25 have been added, claiming the method of implementing apparatus of the present invention.

Restriction Requirement

Applicant renews his traverse of the restriction requirement and respectfully requests the Examiner further consider her decision in light of the below considerations.

Restriction to one of two or more claimed inventions is proper only if the claimed inventions are either "independent" or "distinct" from each other. "Independent" means that there is no disclosed relationship between the two or more subjects disclosed in the application, that they are unconnected in design, operation, or effect. M.P.E.P. §802.01. The examination must also present a substantial burden to the Examiner.

Applicant does not comprehend how the claims are "independent" in this sense. All claims presented incorporate the generic anchor ring for encircling and holding strands of hair, a base support unit and an ornamental unit attached to the base support unit with a hook for removeably attaching it to the anchor ring.

M.P.E.P. §802.01 defines "distinct" as two inventions which are patentable over each other and which have separate utility, i.e., the inventions as claimed "are capable of separate manufacture, use, or sale." Two-way distinctness must be shown, that is, it must be shown that: 1) the combination as claimed does not depend on the particulars of the subcombination for patentability; and 2) the subcombination can be shown to have utility either by itself or in other and different relations M.P.E.P. §806.05(c). In the present invention all of the claims refer to apparatus and (as amended) methods for retaining a pony tail of hair with a decorative element. Applicant therefore does not believe that the required separate utility is present to substantiate the requirement for restriction.

To Applicant's knowledge there is not a substantial burden created by examining the claims together. The claims appear to have the same classification, have the same status in the art and require the same field of search (see M.P.E.P. §808.02).

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Applicant therefore respectfully renews his traverse of the restriction requirement and requests that the Examiner withdraw it.

Information Disclosure Statement

For the convenience of the Examiner, Applicant submits herewith a listing of the patents disclosed within the application on a separate paper, PTO form PTO/SB/08 A. The Applicant requests that the examiner review this prior art. Citations to column and line numbers were by necessity limited to the Summary and drawings sections of the patents cited, as the citations are given context in the patent application itself.

Corrections to the Specification

The Examiner objected to informalities in the specification. Applicant has amended the specification to remove underlining and correct a cited prior art patent number in the paragraph numbered as paragraph [0009] in the publication of this application. The specification has been amended to conform to the examiner's objections, no new matter has been added by these amendments. Withdrawal of these objections to the specification is therefore respectfully requested.

Claim Rejections -35 USC §103

The examiner rejected claims 1-6 and 915 under 35 U.S.C. 103(a) as being unpatentable over "Sterling Ponytail Hair Cuffs and Hair Ties" in view of Edmark et al. U.S. Patent No. 5,355,698 ("Edmark").

Applicant respectfully disagrees that these references render the present invention obvious. There is no suggestion to combine the earlier references. What might be obvious to one of skill in the art at the time of invention can be inferred from the patents granted in the cited prior art. Simply inferring that the present invention is obvious in light of these references is impermissible hindsight.

The question is whether the differences between the prior art and claimed invention as a whole would have been obvious. *Jones v. Hardy*, 727 F.2d 1524, 1529 (Fed. Cir. 1984). The prior art must also be considered as a whole. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1550 (Fed. Cir. 1983), cert. denied, 469

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U.S. 851 (1984). "It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." Application of Wesslau, 353 F.2d 238, 241 (C.C.P.A. 1965); Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, 796 F.2d 443, 448 (Fed. Cir. 1986), cert. denied, 484 U.S. 823 (1987).

There is no suggestion or motivation shown in the prior art to modify or combine the Sterling Hair Tie apparatus with the removable ornamental unit of Edmark. Before prior art references can be combined or modified, there must be some suggestion or motivation found in the art to make the combination or modification. In re Dance, 160 F.3d 1339, 1343 (Fed. Cir. 1998); Heidelberger Druckmaschinen v. Hantscho Commercial, 21 F.3d 1068, 1072 (Fed. Cir. 1994); In re Geiger, 815 F.2d 686, 688 (Fed. Cir. 1987); Lindemann Maschinenfabrik v. Am Hoist and Derrick, 730 F.2d 1452, 1462 (Fed. Cir. 1984). "It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements." Arkie Lures, Inc. v. Gene Larew Tackle, Inc., 119 F.3d 953, 957 (Fed. Cir. 1997).

Alternatively, an additional step of how the knowledge of the skilled artisan leads to the suggestion or motivation to combine at the time of the invention, otherwise this is impermissible hindsight.

The Edmark and Sterling Hair Tie reference therefore cannot be combined to render the present invention obviousness. There have been many attempts in the past to affix decorative devices to hair and to ponytails. No prior art found has addressed presenting a removeable decorative plate for hanging on a ponytail anchor in the same way as the present invention and therefore do not afford the same commensurate utility as does the present invention.

For the reasons above, Applicant therefore respectfully requests that the Examiner withdraw these rejections under §103.

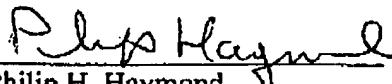
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Conclusion

In light of the foregoing, applicant suggests that the pending claims are now in condition for allowance and respectfully requests a timely Notice of Allowance be issued in this case. Applicant requests that the examiner withdraw her restriction requirement and, if so, allow Applicant the opportunity to amend the claims that currently stand withdrawn.

Respectfully submitted,


Philip H. Haymond
Registration No. 38,177

7545 Irvine Center Drive, Suite 200
Irvine Spectrum Center
Irvine, CA 92618-2933
Tel: (949) 623-8765
Fax: (949) 203-6100